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09/935,917	08/23/2001	Risto Pekka Antero Nokelainen	B1009/7004/DRW/DPM	2006

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EXAMINER

PETERSON, KENNETH E

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/935,917
Filing Date: August 23, 2001
Appellant(s): NOKELAINEN, RISTO PEKKA ANTERO

MAILED

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Group 3700

Daniel McGloughlin
For Appellant

EXAMINER'S ANSWER

This is in response to the corrected appeal brief filed 28 Jan 05 appealing from the Office action mailed 11 July 03. Examiner will, up front, note that this brief was filed under rule 192, and this has been accepted since the original brief was filed prior to September '04.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of claimed subject matter contained in the brief is correct.

(6) Issues to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Groupings of Claims

Independent claims 1,14 and 27 stand or fall on their own, and the other claims stand or fall with them as set forth by Appellant.

(8) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Evidence Relied Upon

4,721,058	Hayamizu et al.	Jan 1988
5,334,126	Moll	Aug 1994
5,787,780	Carter	Aug 1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,2,11,14,15,17,22,23,27,28,30,35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayamizu et al. '058, Moll '126 and Carter'780.

There are several ways to express the teachings of these references. One way is to show that it is obvious to modify Hayamizu with one of the features of Moll. Another way is to modify Moll with one of the features of Hayamizu. The Carter reference does not structural contribute to the rejection, but factually establishes the level of ordinary skill in the art, and is brought into this rejection in support of the Examiner's taking of Official Notice.

Firstly, the Carter reference establishes that it is well known for printers to come with a slitting/perforating option (figure 6, abstract). Whether or not the operator sets the device to slit or to perforate is based upon the following choice;

- A) Slitting – for immediately separating the products, for situations where the products need to sent to diverse locations, or
- B) Perforating – for situations where the products (perforated from one another but still attached) are sent to the same location but will need to be detached

later. The advantages of keeping the products together but perforated is that the sheets, being of set size, are easier to machine-handle and easier to bind with other sheet of the same size, such as a magazine.

The point being that one of ordinary skill knows that slitting and perforating are known alternative choices, depending on the desired outcome. While Examiner deems that the Carter reference is not entirely necessary in this rejection, the Appellant requested that Examiner provide a reference showing that slitting and perforating were known alternatives.

Now that we have established some of the knowledge that one of ordinary skill would possess, we will move onto the rejection proper, which comprises two alternatives,

Alternative #1 – Moll in view of Hayamizu.

Moll shows an apparatus for perforating sheets along the direction of travel of the sheet by controlling when the perforating wheel (76) is activated between a neutral position and a perforating position. Moll also shows a 1st sensor (41) which transmits a 2nd signal to an electronic control device (36), which in turn emits a 1st signal to the perforating wheel to initiate (or not) the perforation of the sheet.

Moll's 2nd control signal is not based on information specific to each sheet. Instead, information specific to each sheet is input by an operator via switches SWI, SWII, SWIII. This is an operator intensive task that just cries out for further

automation. Fortunately, such automation has already been developed by Hayamizu, who shows a slitter that slits in the direction of travel of the sheet movement and includes a bar code reader (10) and a slitter blade that is controlled to move into and out of cutting engagement (figure 11) based upon what the bar code reader reads off of each sheet.

It would have been obvious to one of ordinary skill in the art to have modified Moll by providing a bar code reader (and requiring that all sheets have barcodes on them), as taught by Hayamizu, in order to automate the process of setting when the perforating wheel is activated, thus reducing the work of the operator.

Alternative #2 – Hayamizu in view of Moll.

Hayamizu shows a cutter with most of the limitations including a bar code reader (10) that sends a 2nd signal to a controller (12), which in turn sends a 1st control signal to a blade (90) that is controlled to move into and out of cutting engagement (figure 11).

Hayamizu's blade is a continuous edge blade rather than an intermittent perforating blade. It is well known that the use of perforation blades and non-perforation blades in the same machines is a common feature of many different types of cutting machinery (for example, see Carter).

Moll shows that it is well known to control the actuation of rotary perforating blades (in lieu of cutters), in order to keep all of the products together for later disassembling (see Moll's lines 15-20, column 1). It would have been obvious to one of ordinary skill in the art to have modified Hayamizu by making his blades be perforating

blades, as taught by Moll, in order to keep all of the products together for later disassembling.

(11) Response to Argument

Appellant argues (page 8) that there is no motivation to modify Hiyamizu with the teaching of Moll, since such modification would render Hiyamizu unsatisfactory for its intended purpose. This statement is not true, since separating the drawing from the waste paper at the machine (via slitting) or having the end user separate the drawing from the waste (via tearing along the perforated line) yields the same results (same intended purpose), namely a drawing on an appropriate size of paper. Appellant states that *"cutting blades and perforating blades have entirely different purposes"*. This is quite an exaggeration. While an operator would be inclined to use a slitting blade in some situations and a perforating blade in other situations, the end effect (after tearing along the perforated line) is the same.

Appellant argues (pages 8 and 9) against Examiner taking of Official Notice that perforators and slitters on the same machine are a common feature. Examiner is no longer relying on Official Notice, since the Carter reference has been provided showing as much.

Appellant argues (pages 9 and 10) that it would not be obvious to modify Moll with the bar code reader of Hiyamizu for three reason;

- A) Argument #1 - Because Hiyamizu is directed to paper cutting, not paper perforating. Examiner reiterates that paper cutting and paper

perforating are closely related fields of endeavor, based not only on having the same end effect, but also based on largely similar machinery.

- B) Argument #2 – Because Moll is already automated for perforating large batches of identically perforated sheets. Examiner responds by noting that *“teaching a way is not teaching away”*. Moll teaches one way to automate. Hiyamizu teaches a better, more flexible and less operator intensive way to automate that can achieve everything Moll does and more. Modifying Moll with Hiyamizu's teachings would not in any way decrease Moll's capabilities.
- C) Argument #3 – Because there is no showing of *how* to modify Moll with the teaching's of Hiyamizu. Examiner responds by noting that Hiyamizu shows everything one of ordinary skill would need to upgrade Moll. There is no requirement that the teaching references explicitly describe the bodily incorporation of one device into another.

Appellant argues (page 10), that even if Hayamizu and Moll were combined, the claimed invention would not be shown. However, both Moll and Hiyamizu show the tool being controlled in active and inactive positions. Also, Moll shows individual sheets being fed and sensed (cover figure) and Hiyamizu show successive sheets moving past the controlled slitter.

Specifically, Appellant argues (pages 11,14 and 16) that neither Hiyamizu nor Moll state anything about letting a sheet go by uncut or unperforated. This is a

ridiculous supposition on behalf of the Appellant. Is Appellant suggesting that if one of Hiyamizu's drawings were as wide as the sheet, the bar code would go ahead and indicate that the drawing should be cut down the middle anyway? One of ordinary skill would be smarter than that, and realize that Hiyamizu would have situations where the slitter blade (90) was not activated but instead was held in its neutral position. Likewise, Moll would have situations that require transverse perforation but no longitudinal perforation for the same reason.

Appellant further argues (pages 12,15 and 17) that Hiyamizu does not receive a plurality of individual sheets. However, Hiyamizu does show successive sheets moving past the controlled slitter. Note that Hiyamizu's roll of paper turns into successive sheets after the transverse cutter 69 in the same fashion as Appellant's device. Please compare Hiyamizu's figure 5 with Appellant's figure 2. Both received a roll of paper that is transversely cut into successive sheets. Appellant notes the phrase "*successively receiving a plurality of sheets of paper as input to the perforating device*" found in claims 14 and 27 and "*sheets to be perforated are selected as the group is moving successively through the perforator*" found in claims 1,14 and 27 and wonders exactly what parts of Hiyamizu constitute "*the perforating device*". The answer is that the perforating device is the slitter (84,88,90) modified to be a perforator by Moll. This perforating device (84,88,90) is "*successively receiving a plurality of sheets of paper as input to the perforating device*" and "*the group*" (an arbitrary plurality of sheets) is moving thru the perforating device (84,88,90) at the same time that sheets are being selected by the barcode reader (10) and controller (12). Of course, Appellant's

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arguments in this regard apply only to Hiyamizu in view of Moll, and not Moll in view of Hiyamizu.

Examiner notes that Hiyamizu's reader (10) is upstream of the transverse cutter (69,71), whereas Appellant's reader is downstream of his transverse cutter. Appellant appears to be trying to say that this feature is inferred in his claims, but it is not. The transverse cutter is not claimed at all. At one point in prosecution (28 dec 04), Examiner suggested adding language of this nature, but Appellant chose not to.

(12) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

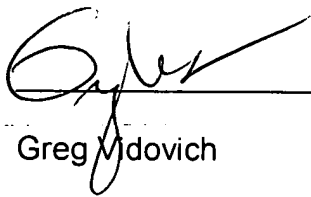
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

KP

Conferees:


KENNETH E. PETERSON
PRIMARY EXAMINER


Greg Miodovich


Allan Shoap